

Amendment
Serial No. 10/764,163
Docket No. 2003-0667.02

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REMARKS

Status of the Claims

Claims 1, 3-7, 9-27, 29-31, 34, and 35 are pending in the present application. Claims 1, 3, 9, and 24 have been amended herein and claims 2, 8, 28, 32, 33 have been canceled herein. New claims 34 and 35 have been added.

Information Disclosure Statement

Applicants submit herewith an Information Disclosure Statement and respectfully request that the Examiner consider the references disclosed therein.

Amendments to the Claims

Claim 1 has been amended to include the step of "determining, by the print device, whether the specified task was carried out successfully by the print device." Additionally, claim 1 has been amended to recite that the step of "generating an email confirmation . . . including an indication of success or failure of said carried out task at said print device" is performed "automatically by the print device." Further, claim 1 has been amended to recited that, "said step of carrying out a specified task includes rendering image data at said print device" and "said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful rendering of said image data."

Claims 3 and 9 have been amended to depend from claim 1.

Claim 24 has been amended to recite "generating an email confirmation by said print device . . ." Additionally, claim 24 has been amended herein to include the step of "determining, by the print device, whether the specified task was carried out

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successfully by the print device." Further, claim 24 has been amended to recite that, "said email confirmation includes a thumbnail image associated with the specified task."

Claims 34 and 35 have been newly added.

Withdrawal of Rejections Under 35 U.S.C. § 102(e)

Applicants assume that the rejections of claims 1-33 under 35 U.S.C. § 102(e) stated in the Office action mailed August 24, 2007, have been withdrawn as this rejection was not restated in the February 5, 2008, Office action.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-33 were rejected in the Office action mailed February 5, 2008, under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 7,019,860 to Matsushima ("Matsushima") in view of U.S. Patent Application Publication No. 2002/0019852 to Bahar ("Bahar"). In light of the amendments to the claims and the arguments herein, it is respectfully submitted that claims 1, 3-7, 9-27, 29-31, 34, and 35 are patentable over the references cited.

Claims 1, 3-7, and 9-15

It is respectfully submitted that the amendments to claim 1, from which claims 3-7 and 9-15 depend, overcome the rejections of claim 1, 3-7, and 9-15 as being allegedly unpatentable over Matsushima in view of Bahar. The rejections of claims 2 and 8 are moot as these claims have been canceled.

First, it is respectfully asserted that neither Matsushima nor Bahar discloses the step of claim 1, as amended, that requires "determining, by the print device, whether the specified task was carried out successfully by the print device." Matsushima discloses printing the content of incoming emails after "the network printer 1 receives an E-mail from an optional sender via the network interface" (Col. 7, lines 30-31). Matsushima does not disclose determining, by the print device, whether a specified task was carried

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out successfully by the print device. Bahar teaches a method for confirming proper receipt of e-mail and does not disclose a step of determining, by a print device, whether a specified task was carried out successfully by the print device. Thus, it is respectfully asserted that the rejection of claim 1 over Matsushima in view of Bahar should be withdrawn at least because neither reference discloses the step of "determining, by the print device, whether the specified task was carried out successfully by the print device."

Even if, for purposes of argument only, it is presumed that Bahar teaches a more generic confirmation system, the device of Bahar does not determine whether a specified task was carried out successfully by a device. The system of Bahar discovers "various recipient information, including identity information associated with the accessing party" from the recipient computer system and then generates a "confirmation of receipt notice." As explicitly stated by Bahar, "In this manner, the sending party can determine whether the accessing party who actually received and was notified of the e-mail file was in fact the intended target party, and thereby determine whether delivery was proper."¹ Thus, it is sending party (a person), not the device at which a specified task was performed, that determines whether delivery was proper. Accordingly, even assuming that Bahar can properly be combined with Matsushima, neither Bahar nor Matsushima discloses the limitation in claim 1 requiring the step of "determining, by the print device, whether the specified task was carried out successfully by the print device."

Second, it is respectfully asserted that neither Matsushima nor Bahar discloses the step of claim 1, as amended, that requires "generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device." Regarding Matsushima, the Office action correctly notes that "Matsushima does not explicitly disclose . . . generating an email confirmation."² Although Bahar discloses a method for confirming proper receipt of e-mail, Bahar does not disclose a system that generates an email confirmation,

¹ Bahar, abstract (emphasis added).

² See Office action, page 3, first full paragraph.

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automatically by a print device, including an indication of success or failure of said carried out task at the print device.

Even if, for purposes of argument only, it is assumed that Bahar may be properly combined with Matsushima, Bahar still fails to disclose a step of generating an email confirmation, automatically by a specific device, including an indication of success or failure of a specific task carried out at that specific device. As discussed above, Bahar requires the sending party to determine success or failure; the confirmation merely provides information to the sending party. Accordingly, even if Bahar can properly be combined with Matsushima, the combination does not disclose the limitation of claim 1 that requires "generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device."

Third, it is respectfully submitted that the cited combination of references does not disclose the limitation of claim 1 that recites, "wherein said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful rendering of said image data." The portions of Matsushima cited in the Office action as disclosing thumbnail images do not, in fact, disclose thumbnail images. Likewise, Bahar does not disclose thumbnail images, and Bahar certainly does not disclose thumbnail images associated with a specified task carried out at a print device. Further still, neither reference discloses the selective inclusion of a thumbnail image as recited in claim 1. Accordingly, claim 1 is patentable over the references cited for at least this additional reason.

In addition, in contrast to the present invention, the system and method of Bahar delivers a confirmation when a party accesses a received email (or the associated email account). Put another way, Bahar discloses a system that delivers a confirmation only after an email message is transmitted over a network and a person takes some action

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to retrieve the email. Thus, the system and method of Bahar only transmits the confirmation once the received email has undergone multiple steps on multiple devices, including at least one step requiring action by a person.³ The method of the present invention, however, includes the step of "generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device" (emphasis added). In short, Bahar's confirmation of end-to-end transmission differs substantially from the present invention's confirmation of success or failure of a specific task at a specific print device.

Further still, the proposed combination of references does not yield the claimed invention. The Office action asserts that one of ordinary skill in the art would be motivated to combine the teachings of Matsushima and Bahar to "actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual." The present invention is not concerned with the identity of an individual who receives an email; instead, the present invention provides an email confirmation, generated by a print device, indicating the success or failure of a specified task at the print device.

Combining the teachings of Bahar with Matsushima would render a system in which some device other than the print device would send an email confirming receipt of the output of the print device. Further, such a device would require some human interaction to trigger the sending of the confirmation email. In direct contrast, the invention of claim 1 requires that the print device determine whether the specified task was carried out successfully by the print device and requires that the print device automatically generate an email confirmation including an indication of success or failure of the task at the print device.

³ See, e.g. paragraph [0029], which states that, "Thus the access event may include any action taken by the accessing party 20 leading to the opening and viewing of the delivered e-mail, including opening and viewing the delivered e-mail itself."

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For at least these reasons, it is respectfully submitted that claims 1, 3-7, and 9-15 are patentable over the cited combination of references. Withdrawal of the rejection of claims 1, 3-7, and 9-15 under § 103(a) is respectfully requested.

Claims 16-23

It is respectfully submitted that the cited combination of references does not disclose all of the steps of the method of claim 16, from which claims 17-23 depend. Specifically, the cited references do not disclose the limitation of claim 16 that requires "generating an email confirmation including an indication of success or failure of said carried out task at said print device, said email confirmation including a thumbnail image associated with said specified task upon successfully carrying out said specified task, and said email confirmation not including a thumbnail image associated with said specified task upon unsuccessfully carrying out said specified task" (emphasis added).

First, for the reasons discussed above regarding claim 1, it is respectfully asserted that the cited references do not disclose "generating an email confirmation including an indication of success or failure of said carried out task at said print device." Accordingly, claims 16-23 are patentable over the references cited for at least this reason.

Second, neither Matsushima nor Bahar discloses the limitation of claim 16 that requires the email confirmation to include "a thumbnail image associated with said specified task upon successfully carrying out said specified task" and the limitation requiring that the email confirmation not include "a thumbnail image associated with said specified task upon unsuccessfully carrying out said specified task." The portions of Matsushima cited in the Office action regarding claim 16 do not disclose the step of claim 16 that requires "generating an email confirmation including a thumbnail image associated with said specified task upon successfully carrying out said specified task, and said email confirmation not including a thumbnail image associated with said specified task upon unsuccessfully carrying out said specified task." Likewise, Bahar

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does not disclose thumbnail images, and Bahar certainly does not disclose thumbnail images associated with a specified task carried out at a print device. Accordingly, claims 16-23 are patentable over the references cited for at least this additional reason.

In addition, as discussed above with regard to claim 1, the proposed combination of references does not yield the claimed invention.

For at least these reasons, it is respectfully submitted that claims 16-23 are patentable over the cited combination of references. Withdrawal of the rejection of claims 16-23 under § 103(a) is respectfully requested.

Claim 24-27 and 29-31

It is respectfully submitted that the amendments to claim 24, from which claims 25-27 and 29-31 depend, overcome the rejections of claim 24-27 and 29-31 as being allegedly unpatentable over Matsushima in view of Bahar. The rejection of claim 28 is moot due to cancelation of claim 28.

Specifically, claim 24 has been amended to include limitations requiring the step of "determining, by the print device, whether the specified task was carried out successfully by the print device" and reciting that the "email confirmation includes a thumbnail image associated with the specified task." As discussed above with regard to claims 1 and 16, neither Matsushima nor Bahar discloses either of these steps. Thus, claims 24-27 and 29-31 are patentable over the cited combination of references for at least these reasons.

In addition, as discussed above with regard to claim 1, the proposed combination of references does not yield the claimed invention.

For at least these reasons, it is respectfully submitted that claims 24-27 and 29-31 are patentable over the cited combination of references. Withdrawal of the rejection of claims 24-27 and 29-31 under § 103(a) is respectfully requested.

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Claims 32-33

The rejections of claims 32 and 33 are moot due to the cancelation of these claims.

New Claims 34-35

It is respectfully submitted that new claims 34 and 35 are patentable over the combination of references cited. First, claim 34, from which claim 35 depends, includes the step of "determining, by the print device, whether the specified task was carried out successfully by the print device." As discussed above, this step is not disclosed by the cited combination of references. Second, claim 34 includes the step of "generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device." As discussed above, this step is not disclosed by the cited combination of references. Third, claim 34 recites, "wherein said email confirmation relates to a scan to network job." Neither Matsushima nor Bahar discloses the use of a print device for a scan to network job. For at least these reasons, it is respectfully submitted that claims 34 and 35 are patentable over the cited combination of references.

Conclusion

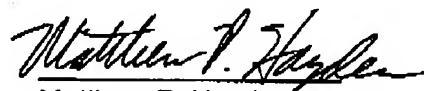
It is respectfully submitted that claims 1, 3-7, 9-27, 29-31, 34, and 35, now pending, are patentably distinct from the references cited and are in condition for allowance. Reconsideration and withdrawal of the rejection of record are respectfully requested.

The Commissioner for Patents is hereby authorized to charge any additional fees that may be required by this paper, or to credit any overpayment to Deposit Account 50-3072.

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In the event that the Examiner wishes to discuss any aspect of this response,
please contact the undersigned at the telephone number indicated below.

Respectfully submitted,



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